

REMARKS

Claims 23-39 were pending in the present application. Claims 23-34 and 38-39 were withdrawn from consideration. By virtue of this response, claim 35 and 36 have been amended. Accordingly, claims 35-37 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. No new matter has been added.

Applicant appreciates the Examiner's indication that all previously made rejections of claims 35-37 have been withdrawn.

Sequence Rules

With regard to the sequence disclosures in the figures, Applicant has amended the brief description of Figures 1 and 2 as appropriate to identify SEQ ID NO's.

New Matter in Specification

With regard to the rejections under 35 U.S.C. §112, first paragraph, Applicant has amended the specification (which was previously amended on September 25, 2002) to remove the reference to "agonist." Applicant respectfully points out to the Examiner that the specification as filed supports a screening assay to identify "antagonists." See, for example, page 22, lines 22-25 of the specification.

Written Description and Enablement Requirement

With regard to the objections relative to the written description requirement and the enablement requirement, it is respectfully submitted that these requirements are met with respect to the screening method recited in the claims, as amended.

For example, it is described at page 22, lines 22-25, that "The ET-receptors obtained are useful in screening for an antagonist of the ER-receptors . . ." Thus, the subject matter of the claims

does not depend on the specification amendment for support. On the contrary, the specification as filed clearly describes the “screening” subject matter in such a way to convey that the inventor(s) had possession of the claimed invention.

As for enablement, the claims as amended are directed to a screening protocol which, as the Examiner has recognized, is described in a manner so as to be capable of being carried out by one of ordinary skill in the art. In particular, at page 5 of the Office Action dated May 7, 2003, the Examiner has stated that “. . . the Examiner accepts that the screening protocol contained in claims 35, 36 and 37 could be practiced” (going on to criticize the “treatment” recitation formerly in the preamble of claim 35).

The specification does indeed disclose guidance on the use of the screening method. For example, at page 22, lines 23-25, it is clearly stated that the method is useful in screening for an antagonist of the ET-receptors so as to study agents for the circulatory system. Further, the screening method recited in the claims can be directed to any “candidate compound.” The screening method enables detection of compounds which bind to the receptor. Since the claim is directed to a screening method *per se*, there is no requirement for an expectation of success for every compound screened.

The claimed genus (i.e., a screening method of using the ET-receptor) is well characterized and defined. As discussed above, the specification describes the use of the ET-receptor in screening. One skilled in the art can clearly carry out the claimed method, and the subject matter of the present claims is enabled as required by 35 U.S.C. §112, first paragraph..

With respect to the University of Rochester case, this case was directed to alleged “reach through” claims. Since the claims, as amended, of the present application are directed to a screening method *per se*, the University of Rochester case is not applicable.

Indefiniteness

Finally, the Examiner contends that the recitation of an amino acid sequence of SEQ ID NO: 1 is indefinite. Applicant points out that the SEQ ID NO: 1 shows the DNA sequence and deduced amino acid sequence of the ET_A receptor. Thus, the recitation of SEQ ID NO: 1 is not indefinite.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 299002032411. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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